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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,859	06/08/2000	Steven Casagrande	159008-0003	9867
24267	7590	05/16/2005	EXAMINER	
CESARI AND MCKENNA, LLP 88 BLACK FALCON AVENUE BOSTON, MA 02210			KIM, JUNG W	
		ART UNIT		PAPER NUMBER
				2132

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
09/590,859	CASAGRANDE, STEVEN	
Examiner	Art Unit	
Jung W. Kim	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on 01 April 2005.
- 2a)  This action is FINAL.                            2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4)  Claim(s) 16-32 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) 20 and 26 is/are allowed.
- 6)  Claim(s) 16-19,21-25,27-32 and 37-39 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on 01 April 2005 is/are: a)  accepted or b)  objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All    b)  Some \* c)  None of:
  1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

1. Claims 16-32 and 37-39 are pending.
2. Applicant amended claims 16-20, 22, 24-29, 31 and 32 in the amendment filed on April 1, 2005.
3. Claims 33-36 were canceled.
4. Claims 37-39 are new.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Continued Examination Under 37 CFR 1.114***

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 1, 2005 has been entered.

***Drawings***

7. The drawings were received on April 1, 2005. These drawings are acceptable.

***Response to Amendment***

8. The 112, 2<sup>nd</sup> paragraph rejections to claims 16, 18 and 25 for lack of antecedent basis and the 112, 2<sup>nd</sup> paragraph rejections to claims 20 and 26 for reciting a relative term are withdrawn as the amendment overcomes the 112, 2<sup>nd</sup> paragraph rejections; however, as outlined below, claims 16-19, 25 and 27 are rejected under 112, 2<sup>nd</sup> paragraph for omitting essential steps.

***Response to Arguments***

9. Applicant's arguments with respect to claims 16-19, 21-25, 27-32 and 37-39 have been fully considered and are persuasive; hence, the 35 U.S.C. 103(a) rejections are withdrawn. Therefore, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of LeBourgeois PCT WO 98/42098, LeBourgeois USPN 6,026,166 and Swift et al. USPN 6,377,691 under 102(a) and 103(a) for claims 21-24, 28-32 and 37-39.

***Claim Objections***

10. Claims 17, 21, 38 and 39 is objected to because of the following informalities: in claim 17, replace "ay" with "at" on line 2; in claim 21, replace the phrase "to only execute on the computer comprising" recited on line 2, with "to only execute on the computer", in claim 38, add an apostrophe in line 6 and 11; in claim 39, add an apostrophe in line 4. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 16-19, 25 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: in claim 16, creating, at the computer, the single value to decrypt the encrypted software; without this step, it not clear how the computer has access to the single value for the purpose of decrypting the encrypted software product as recited in lines 18 and 19; in claims 18 and 25, an intermediary step between the step of decrypting, at the computer, members of the set of encrypted single values and the step of authorizing access; without this step, it not clear how authorization is dependent on the prior steps.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

14. Claims 23, 24, 31, 32, 37 and 39 are rejected under 35 U.S.C. 102(a) as being anticipated by LeBourgeois PCT WO 98/42098 (hereinafter LeBourgeois '098).

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15. As per claims 23 and 24, LeBourgeois '098 discloses a process for protecting a software product, sent from a server computer to a computer, from unauthorized usage (pg 5, line 15-pg. 8, line 13), the process comprising the steps of:

- a. encrypting, at the server computer, the software product before it has been sent to the computer by using a first set of data collected from the computer as the encryption key (pg. 27, lines 21-30; fig. 9, reference no. 902),
- b. sending the encrypted software product to the computer (fig. 9, reference no. 908),
- c. requesting access to the encrypted software product at the computer and in response thereto, generating a second set of data from the computer (pg. 29, 7-16; fig. 11, reference no. 1102), and
- d. decrypting the encrypted software product by using the second set of data as the decryption key (pg. 29, 16-27; fig. 11, reference no. 1104);
- e. wherein the software comprises at least one data file or streaming data or both (pg. 16, line 13-pg. 17, line 2; the software product necessarily comprises at least one data file).

The aforementioned cover the limitations of claims 23 and 24.

16. As per claims 31 and 32, the rejections of claims 23 and 24 under 35 U.S.C. 102(a) are incorporated herein. (supra) In addition, LeBourgeois discloses the steps of:

- f. generating a set of data from the computer before the software product is encrypted at the server (pg. 21, line 5-pg. 25, line 2; fig. 6, reference no. 602),

g. sending the set of data to the server computer before the software product is encrypted at the server (fig. 6, reference no. 610; fig. 8),

17. The aforementioned cover the limitations of claims 31 and 32.

18. As per claim 37, it is a claim corresponding to claims 23 and 24, and it does not teach or define above the information claimed in claims 23 and 24. Therefore, claim 37 is rejected as being anticipated by LeBourgeois '098 for the same reasons set forth in the rejections of claims 23 and 24.

19. As per claim 39, it is a system claim corresponding to claims 31 and 32, and it does not teach or define above the information claimed in claims 31 and 32. Therefore, claim 39 is rejected as being anticipated by LeBourgeois '098 for the same reasons set forth in the rejections of claims 31 and 32.

***Claim Rejections - 35 USC § 103***

20. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being rejected over LeBourgeois '098 in view of Reardon USPN 6,212,635 (hereinafter Reardon).

21. As per claims 21 and 22, LeBourgeois '098 discloses a process for restricting a software product, downloaded from a server computer to a computer, to only execute on the computer, the process comprising the steps of:

- h. encrypting, at the server computer, the software product using a first encryption key (pg. 27, lines 21-30; fig. 9, reference no. 904),
- i. encrypting at the server computer, the first encryption key by using the first set of data as the encryption key (pg. 27, lines 31-33; fig. 9, reference no. 902),
- j. downloading the encrypted first encryption key and the encrypted software product to the computer (fig. 9, reference no. 908),
- k. requesting access to the encrypted software product at the computer, and in response thereto, generating a second set of data from the computer (pg. 29, 7-16; fig. 11, reference no. 1102),
- l. decrypting the encrypted first encryption key using the second set of data as the decryption key (pg. 30, lines 20-30),
- m. decrypting the encrypted software product by using the resultant of the decryption of the encrypted first encryption key as the decryption key (pg. 30, lines 31-33);
- n. wherein the software product comprises at least one data file or streaming data or both (pg. 16, line 13-pg. 17, line 2; the software product necessarily comprises at least one data file).

22. LeBourgeois '098 does not disclose the first encryption key is created from a first set of data collected from the computer. Reardon discloses collecting information about the computer configuration and network of the computer from a user or directly from a CPU and hashing these values to create a unique seed to generate an encryption key.

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Reardon, 10:40-59. It would be obvious to one of ordinary skill in the art at the time the invention was made to create the first encryption key from a first set of data collect from the computer since it ensures only authorized use of the product by securely linking the encryption key with the unique profile of a computer. Reardon, 10:54-55. The aforementioned cover the limitations of claims 21 and 22.

23. Claims 28, 29 and 38 are rejected under 35 U.S.C. 103(a) as being rejected over LeBourgeois USPN 6,026,166 (hereinafter LeBourgeois '166) in view of LeBourgeois '098.

24. As per claim 28 and 29, LeBourgeois '166 discloses a process for protecting a software product from unauthorized usage by authenticating a computer before the software product is downloaded from a server computer to the computer, the process comprising the steps of:

- o. generating a first set of parameters from the computer before the software product is downloaded to the computer (fig. 1, step 1; fig. 3A, reference no. 314; fig. 4),
- p. sending the first set of parameters to the server computer before the software product is downloaded to the computer (fig. 3A, reference no. 316),
- q. storing the first set of parameters at the server computer (fig. 3A, reference no. 318),

- r. instructing a software application, performed by a user, to download the software product, and in response thereto, generating a second set of parameters from the computer, and sending the second set of parameters to the server computer before the software product is downloaded to the computer (fig. 1, steps 4 and 5; fig. 3A, reference nos. 320, 322, 324, 326, 328; fig. 3B, reference nos. 330, 332, 334; fig. 5),
- s. comparing, at the server computer, the first set of parameters to the second set of parameters (fig. 3B, reference nos. 336, 338; fig. 7), and
- t. downloading the software product to the computer (fig. 3B, reference no. 346).

25. LeBourgeois '166 does not expressly teach executing a license agreement by a user for the software product for the computer prior to the step of generating a first set of parameters; wherein the software product comprises at least one data file or streaming data or both. LeBourgeois '098 discloses means for a user to purchase a license to use a software product on a computer prior to the step of generating a first set of parameters on the user's computer; the software product necessarily comprises at least one data file. LeBourgeois '098, fig. 5, reference nos. 506, 508, 510 and 512; pg. 16, line 13-pg. 17, line 2. It would be obvious to one of ordinary skill in the art at the time the invention was made for the user to execute a license agreement for a software product prior to steps to being preliminary authentication of the user, since a license agreement legally binds a user to limited use of the product, and furthermore, the steps to verify the user are moot if the user does not agree to the use conditions required by

the license agreement. LeBourgeois '098, *ibid.*, see also pg. 1, first paragraph; pg. 5, 1<sup>st</sup> full paragraph. The aforementioned cover the limitations of claims 28 and 29.

26. As per claim 38, it is a claim corresponding to claims 28 and 29, and it does not teach or define above the information claimed in claims 28 and 29. Therefore, claim 38 is rejected as being unpatentable over LeBourgeois '166 in view of LeBourgeois '098 for the same reasons set forth in the rejections of claims 28 and 29.

27. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over LeBourgeois '166 in view of LeBourgeois '098, and further in view of Swift et al. USPN 6,377,691 (hereinafter Swift).

28. As per claim 30, the rejections of claims 28 and 29 under 35 U.S.C. 103(a) are incorporated herein. (*supra*) LeBourgeois '166 does not disclose steps in the event of a download failure or interruption, wherein the computer is reauthenticated to resume the download of the software product to the computer. However, it is notoriously well known in the art for authenticated clients communicating with a server to reauthenticate with the server when a connection between the client and server fails. Rather than take Official notice of this teaching, examiner points to the disclosure of Swift, wherein such a reauthentication feature is taught for a connection-oriented transmission. Swift, col. 2:22-56. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made for the method of LeBourgeois '166 to include reauthentication

steps of the user to the server by submitting a third set of parameters from the computer to the server computer, since a termination of the connection obviates the authenticated identity of the user (the end of the communication session). Swift, *ibid*. The aforementioned cover the limitations of claim 30.

***Allowable Subject Matter***

29. Claims 20 and 26 are allowed
30. Claims 16-19, 25 and 27 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jung W. Kim whose telephone number is (571) 272-3804. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jung W Kim  
Examiner  
Art Unit 2132

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May 5, 2005



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